

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed December 9, 2004, is respectfully requested. Claim 1-4, 12-19, 21, 24-25, and 27 have been amended. Claims 30 has been newly added. Claims 1-10 and 12-30 remain pending in this case. Specification support for these amendments can be found at, e.g., paragraphs 0003-0005, 0026, 0033, 0044, 0069, and 0709 (Example 102). Therefore, these amendments are made without introducing new matter.

Claim 30 specifically claims one of the compounds listed in claim 10 (hexadecanoic acid 4,5-dihydroxy-6-{2-methyl-1-[(4-propyl-piperidine-2-carbonyl)-amino]-propyl}-2-methylsulfanyl-tetrahydro-pyran-3-yl ester). Therefore, this claim is patentable for the same reasons as applicable to claim 10.

35 U.S.C. § 112

Claims 1-8 and 20-24 were rejected under 35 U.S.C. § 112, first paragraph. In particular, the examiner has taken the position that the specification does not reasonably provide enablement for the terms “substituted oxygen” or “substituted nitrogen.” Applicants have replaced these terms with the groups “-OR^d” and “-NR^cR^f,” respectively. Support for these amendments can be found in paragraphs 0069 and 0044, which contain the definitions of “substituted oxygen” and “substituted nitrogen,” respectively.

Claims 21-23 and 27-29 were rejected under 35 U.S.C. § 112, first paragraph. The examiner has taken the position that the specification does not reasonably provide enablement for the treatment of microbial infections. Applicants have amended the claims to specify that the

Patent
Attorney Docket: 892,280-603
(formerly 342312004920)

compounds can be used in the treatment of bacterial infections. Support for this amendment can be found throughout the specification (e.g., paragraphs 0003-0005, and 0033).

Claims 1-8 and 12-29 were rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. As suggested by the examiner, applicants have amended the claims to include the terminology “or a prodrug, tautomer, or a pharmaceutically acceptable salt thereof” or similar language.

Double Patenting

Claims 1-10 and 12-29 were provisionally rejected under the judicially created obviousness-type double patenting as being allegedly unpatentable over claims 1-11 of co-pending application no. 10/642,807. Applicants note that the ‘807 application is not yet allowed or issued. Therefore, Applicants will address this rejection upon an indication of allowance in the other case.

Patent
Attorney Docket: 892,280-603
(formerly 342312004920)

Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact the applicants' undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any fees that may be required in connection with the filing of these documents to Deposit Account No. 50-2862.

Respectfully submitted,

Dated: May 9, 2005

By: Diane K Wong
Diane K. Wong
Reg. No. 54,550

JCK/DKW/cp

O'Melveny & Myers LLP
114 Pacifica, Suite 100
Irvine, CA 92618
(949) 737-2900